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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,433	10/14/2003	W. Todd Daniell	190250-1580	7279
38823 7590 05/07/2007 THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP/ BELLSOUTH I.P. CORP 100 GALLERIA PARKWAY SUITE 1750 ATLANTA, GA 30339				
			EXAMINER LAI, MICHAEL C	
			ART UNIT 2109	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/686,433

Applicant(s)

DANIELL, W. TODD

Examiner

Michael C. Lai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-25 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 14 October 2003.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Priority

This application has no priority claim made. The filing date is 10/14/2003.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 10/14/2003 was filed on the mailing date of the application on 10/14/2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

The Abstract is objected to because the use of legal terminology such as "comprise" (line 8).

Appropriate correction is required. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (e.g. line 5 page 19).

Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Double Patenting

Claims 1-3 and 18-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 6, 9-10 of copending Application No. 10/686,431 (Initiating instant messaging (IM) chat sessions from email messages). Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the two pending applications are minor wording, which do not change the scope of the invention. Refer to the below observation for obvious variations of limitation in claims 1-3 and 18-21 of the instant application and claims 1, 3, 6, 9-10

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of the pending application. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Instant Application 10/686,433	Pending Application 10/686,431
<p>1. A method for handling digital messages, the method comprising the steps of: determining whether an email message meets a predefined condition; and executing an action in an instant messaging (IM) system in response to determining that the email message meets the predefined condition.</p> <p>2. The method of claim 1, wherein the step of determining whether the email message meets a predefined condition comprises the step of extracting contact information from the email message, the contact information being associated with a sender of the email message.</p> <p>3. The method of claim 2, wherein the step of executing the action in the IM system comprises the steps of: determining a presence of the sender using the extracted contact information, the presence being indicative of whether the user is present online; and initiating an IM chat session with the sender in response to determining that the sender is present online.</p> <p>18. A system for handling digital messages, the system comprising: means for determining whether an email message meets a predefined condition; and means for executing an action in an instant messaging (IM) system in response to determining that the email message meets the predefined condition.</p> <p>19. A system for handling digital messages, the system comprising: condition-determination logic adapted to determine whether an email message meets a predefined condition; and command execution logic adapted to execute an action in an instant messaging (IM) system in response to determining that the email message meets the predefined condition.</p>	<p>1. A method comprising the steps of: determining an Internet presence of a contact identified in an email message; and initiating an instant messaging (IM) chat session with the contact in response to determining that the contact is present.</p> <p>2. The method of claim 1, wherein the step of initiating the IM chat session comprises the steps of: generating an IM chat window; obtaining information from the email message; and displaying the obtained information in the generated IM chat window.</p> <p>3. The method of claim 2, wherein the step of obtaining information from the email message comprises the step of: obtaining a subject of the email message.</p> <p>6. The method of claim 2, wherein the step of obtaining information from the email message comprises the step of: obtaining a body of the email message.</p> <p>9. A system comprising: means for determining an Internet presence of a contact identified in an email message; and means for initiating an instant messaging (IM) chat session with the contact in response to determining that the contact is present.</p> <p>10. A system comprising: presence logic configured to determine an Internet presence of a contact identified in an email message; and chat-initiation logic configured to initiate an instant messaging (IM) chat session with the contact in response to determine that the contact is present.</p>

<p>20. The system of claim 19, further comprising information-extraction logic adapted to extract contact information from the email message, the contact information being associated with a sender of the email message.</p> <p>21. The system of claim 20, further comprising: presence-determination logic adapted to determine a presence of the sender using the extracted contact information, the presence being indicative of whether the user is present online; and IM-chat-initiation logic adapted to initiate an IM chat session with the sender in response to determining that the sender is present online.</p>	
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Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-17 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 10-17 recite the limitation of "A computer-readable medium..." that is described in lines 3-8 on page 27 of original specification as "In the context of this document, a "computer-readable medium" can be any means that can contain, store, communicate, propagate, or transport the program for use by or in connection with the instruction execution system, apparatus, or device. The computer-readable medium can be, for example but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation medium." A propagation medium includes signals. As such, the claims cover embodiments directed to signals, per se. These claims are being rejected as non-statutory

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as directed to a form of energy rather than a patent-eligible machine, manufacture, process or composition of matter.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

a. A person shall be entitled to a patent unless –

b. (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 8, 10-12, 15-21, 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Appelman et al. (6,912,564), hereinafter referred to as Appelman.

3. Regarding claims 1-2, and 8, Appelman disclosed a method to store the attributes of the electronic data and then use them for subscriber defined filtering purpose (Fig. 6 and Col. 12 lines 53-60).

4. Regarding claim 3, Appelman disclosed a method comprising: an email read window configured to display a received email message from a contact; and an icon indicative of instant messaging (IM) presence information of the contact, the icon being displayed on the email read window (Fig. 10). The examiner notes that the running man icon in Fig. 10 is equivalent to “indicative of whether the user is present online.”

5. Regarding claims 10-12, Appelman disclosed an IM server in Fig. 5 and Col. 9 lines 38-46: By accessing the IM server 5902 and/or the domain server 5904, a subscriber can use the IM client application to view whether particular subscribers ("buddies") are online, exchange instant

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messages with particular subscribers, participate in group chat rooms, trade files such as pictures, invitations or documents, find other subscribers with similar interests, get customized news and stock quotes, and search the World Wide Web.

6. Regarding claims 15-21, 24-25, Appelman disclosed a system comprising: an email read window configured to display a received email message from a contact; and an icon indicative of instant messaging (IM) presence information of the contact, the icon being displayed on the email read window (Fig. 10). The examiner notes that the running man icon in Fig. 10 is equivalent to "indicative of whether the user is present online."

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4-5, 13-14, 22-23 rejected under 35 U.S.C. 103(a) as being unpatentable over Thurlow (U.S. Patent Number 6,057,841) in view of Monday (U.S. Patent Number 6,480,860).

3. Regarding claims 4-5, 13-14, 22-23, Thurlow disclosed a "rules wizard" permitting the user to select various permutations of conditions, actions, and exceptions. Thurlow presented the rule in a natural language format, not a markup language. Monday disclosed a method for accessing data stored in a predefined format in a database using a tagged markup language interface. Together Thurlow and Monday disclosed all limitations of claims 4-5, 13-14, 22-23. The examiner notes that Thurlow only disclosed his invention for email communication.

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However, instant messages are another kind of electronic messages. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine instant messaging with email to obtain the invention as specified in claims 4-5, 13-14, 22-23.

4. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thurlow in view of Monday applied to claims 4-5 above, and further in view of Appelman. Thurlow and Monday did not disclose file request and transmission in their invention. However, Appelman disclosed an IM server in Fig. 5 and Col. 9 lines 38-46: By accessing the IM server 5902 and/or the domain server 5904, a subscriber can use the IM client application to view whether particular subscribers ("buddies") are online, exchange instant messages with particular subscribers, participate in group chat rooms, trade files such as pictures, invitations or documents, find other subscribers with similar interests, get customized news and stock quotes, and search the World Wide Web. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine file request/transmission as specified in claims 6-7.

Claim 9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Lai whose telephone number is (571) 270-3236. The examiner can normally be reached on M-F 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef can be reached on (571) 272-5026. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael C. Lai
13APR2007


MARVIN LATEEF
SUPERVISORY PATENT EXAMINER